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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,680	12/04/2003	Dan Peters	2815-0253P	5690

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EXAMINER

HUANG, EVELYN MEI

ART UNIT PAPER NUMBER

3999

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,680

Applicant(s)

PETERS ET AL.

Examiner

Evelyn Huang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 11, 26 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 11, 39 is/are allowed.
- 6) ☒ Claim(s) 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/864367.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 11, 26, 39 are pending. Claims 8, 10, 12, 13, 27-35, 39 have been canceled according to the amendment filed on 5-20-2005. Claims 2-7, 9, 14-25, 36-37 have been canceled according to the preliminary amendment filed on 2-22-2004.

Claim Rejections - 35 USC § 112

2. The rejection for Claims 1, 11, 13, 26-35 under 35 U.S.C. 112, second paragraph is withdrawn in view of the amendment obviating the rejection.

Claim Rejections - 35 USC § 112

3. The rejection for Claims 27, 28 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is rendered moot by the cancellation of these claims.

Claim Rejections - 35 USC § 112

4. The rejection for Claims 27-35 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is rendered moot by the cancellation of these claims.

Claim Rejections - 35 USC § 102

5. The rejection for Claims 1, 11 under 35 U.S.C. 102(b) as being anticipated by Gaster (5919932) is withdrawn in view of the amendment limiting the compound of formula I to be an azabicyclic[3.2.1]oct-2-ene, thereby setting a demarcation from Gaster's azabicyclic[3.2.1]-octane compound of Description 7 (column 8).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for process A, does not reasonably provide enablement for process B. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Process B is directed to the method of reducing a N-Boc-azabicyclo[3.2.1]oct-ene compound of formula IV to arrive at the inventive compound of formula I.

A definition of 'reducing' in process B, or an example thereof, is not found in the specification.

According to Hawley's Condensed Chemical Dictionary, 14th Edition, Copyright ©2002 by John Wiley & Sons, Inc., *reduction is (1) The opposite of oxidation. Reduction may occur in the following ways: (a) acceptance of one or more electrons by an atom or ion, (b) removal of oxygen from a compound, (c) addition of hydrogen to a compound.* In the instant case, it would mean adding hydrogen across the double bond of the azabicyclo[3.2.1]-octane of formula IV to yield the corresponding azabicyclo[3.2.1]octane, and would not lead to the production of the azabicyclo[3.2.1]octene compound of formula I as claimed. One of ordinary skill in the art would not be able to make the compound of formula I as claimed without undue experimentation.

Allowable Subject Matter

7. Claims 1, 11, 39 are allowed.

The compound of the invention is an azabicyclo[3.2.1]oct-ene whereas the compound of Description 7 of Gaster (5919932) is an azabicyclo[3.2.1]octane. Motivation to modify Gaster's intermediate compound to arrive at the instant invention is lacking.

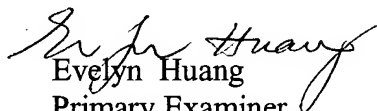
Art Unit: 1625

The compounds of Audia (6107307, PTO-1449; column 15, Examples 1-2; columns 17-19, Examples 8-12) have the bicyclic heterocyclic ring attached to the azabicyclic [3.2.1]octene via the hetero ring of the bicyclo, whereas the bicyclic heterocyclic ring is attached to the azabicyclic [3.2.1]octene via the benzene ring of the bicyclo in the instant compounds. Lacking is the motivation to modify Audia's compounds to arrive at the instant invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Evelyn Huang
Primary Examiner
Art Unit 1625